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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO.    |
|---|-------------|----------------------|---------------------|---------------------|
| 10/684,474  | 10/15/2003  | Yoshiaki Kawamozzen  | 243933US0SRD        | 6692                |
| 22850   | 7590        | 10/26/2005           |                     | EXAMINER            |
| OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.<br>1940 DUKE STREET<br>ALEXANDRIA, VA 22314 |             |                      |                     | PETKOVSEK, DANIEL J |
|   |             |                      | ART UNIT            | PAPER NUMBER        |
|   |             |                      | 2874                |                     |

DATE MAILED: 10/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |  |                                       |
|------------------------------|--|---------------------------------------|
| <b>Office Action Summary</b> | Application No.  | Applicant(s)                          |
|                              | 10/684,474<br>Examiner <i>Daniel J. Petkovsek</i><br>Daniel J. Petkovsek | KAWAMONZEN ET AL.<br>Art Unit<br>2874 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on election filed October 5, 2005.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-19 is/are pending in the application.  
 4a) Of the above claim(s) 18 is/are withdrawn from consideration.  
 5) Claim(s) 1-17, and 19 is/are allowed.  
 6) Claim(s) \_\_\_\_\_ is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on February 9, 2004 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date 10/15/03.

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_.

## DETAILED ACTION

This office action is in response to the election filed October 5, 2005.

### *Election/Restrictions*

1. Applicant's election with traverse of the restriction of claim 18 in the reply filed on October 5, 2005 is acknowledged. The traversal is on the grounds that the Groups are not unrelated and that "thousands of U.S. patents have issued in which more than two subclasses have been *searched...*". This is not found persuasive because the Examiner did not state that only two subclasses were to be searched; however, the Examiner stated that the two different inventions were to be *classified* in two different subclasses. In such language the difference exists. Also, the level of "relatedness" is an extremely subjective term, and the Examiner feels that there are patentable distinctions between the two different invention. In a sense, a doorknob is "related" to a door, but they can be patentably distinct. Of course, if the Applicant would like to state on the record that there is no patentable distinction between the claim scope of Groups I and II, the Examiner would willingly rejoin the non-elected group (claim 18).

The requirement is still deemed proper and is therefore made **FINAL**.

2. This application is in condition for allowance except for the presence of claim 18 to an invention non-elected with traverse in the reply filed on October 5, 2005. Applicant is given ONE MONTH or THIRTY DAYS from the date of this letter, whichever is longer, to cancel the noted claims or take other appropriate action (37 CFR 1.144). Failure to take action during this period will be treated as authorization to cancel the noted claims by Examiner's Amendment and

pass the case to issue. Extensions of time under 37 CFR 1.136(a) will not be permitted since this application will be passed to issue.

The prosecution of this case is closed except for consideration of the above matter.

***Information Disclosure Statement***

3. The prior art documents submitted by Applicant in the Information Disclosure Statements filed on October 15, 2003, have been considered and made of record (note attached copy of forms PTO-1449).

***Allowable Subject Matter***

4. Claims 1-17 and 19 are allowed. The following is a statement of reasons for the indication of allowable subject matter: the relevant prior art of record does not teach or reasonably suggest the specific polyimide *optical* material comprising *heterocyclic* polyimide with the specific formula comprising (1)-(3) (claim 1). The closest prior art of record as listed in the IDS filed October 15, 2003 does not teach or reasonably suggest the specific polyimide as formed by the sole independent claim 1. The prior art comprises other polymers than the polyimides of the current application.

***Inventorship***

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any

evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

***Conclusion***

6. This application is in condition for allowance except for the following formal matters:  
Claim 18 must be formally canceled.

Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

A shortened statutory period for reply to this action is set to expire **TWO MONTHS** from the mailing date of this letter. However, please note in the restriction paragraph above that the matter of the non-elected claims (with traverse) must be responded to within **ONE MONTH**.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel J. Petkovsek whose telephone number is (571) 272-2355. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rodney Bovernick can be reached on (571) 272-2344. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2874

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*DAN*  
Daniel Petkovsek  
October 21, 2005

*Michelle R. Connelly-Cushwa*  
MICHELLE CONNELLY-CUSHWA  
PRIMARY EXAMINER  
*10/25/05*